



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,171	12/29/2000	Victor R. Sanchez	CAS1PAU24R2	9702

7590 05/21/2002

Myers, Dawes & Andras
19900 MacArthur Boulevard
Suite 1150
Irvine, CA 92612

EXAMINER	
CORBIN, ARTHUR L	
ART UNIT	PAPER NUMBER
1761	11

DATE MAILED: 05/21/2002

DL - 08/21/02 w/o ext.

DL - 11/21/02 w/ 3 mo. ext.

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
MAY 28 2002

Office Action Summary

Application No.

09(753,171

Applicant(s)

SAENZ ET AL

Examiner

ARTHUR L. CORBIN 1761

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4-12-02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 38-57 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 38-57 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Applicant is referred to paragraph No. 7, Paper No. 7.

2. Claims 38-57 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3. Claims 38-57 are rejected under 35 USC 251 as lacking basis for reissue, as set forth in paragraph No. 9, Paper No. 7.

4. Claims 38-57 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two-year statutory period. Applicant is referred to paragraph No. 10, Paper No. 7 for an identification of the broadened claim limitations. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

5. Applicant's arguments filed April 12, 2002 have been fully considered but they are not persuasive. Since there are other errors at issue in the instant application which ^{WERE} ~~WERE~~ not present in the parent reissue application, as applicant indicates (page 10 of remarks), at least one of these other errors must be identified in the reissue declaration

of the instant application. The reasons for further broadening the claims in the instant reissue application are unrelated to the reasons originally presented for filing the parent reissue application. Thus, in any request for reissue in which a new set of facts is relied upon in support of errors in the patent, a copy of a declaration filed in a previous reissue, i.e. parent reissue, could not possibly comply with the requirements of 37 CFR 1.175. The only error in said declaration copy was related to the original patent, which is not the patent for which this continuation reissue is now seeking reissue. Thus it could be argued that the instant continuation reissue application was filed as a "no defect" reissue.

Applicant's attempt to justify the broadening in the instant reissue application outside of the two-year statutory period based upon In re Doll is without merit. In Doll, it was held that if a broadening reissue application was filed within the two year period permitted by 35 USC 251, then a further broadening of the claims, within that application, which occurs after the two years has expired, is permitted.

The facts at issue herein differ from Doll in that this is a continuation reissue, i.e. a separate application from the parent reissue, based upon a set of facts which are totally unrelated to the facts which caused the parent reissue to be filed. If the facts which led to the filing of the first broadened reissue (parent) had not occurred, so that there had been no need to file the first ^{or} ~~parent~~ parent reissue application, there is no question that applicant would not be able to broaden the patent claims at the date of filing of the instant reissue application. Thus, if the facts were entirely the same here except that there had been no need to file the first or parent reissue application,

Art Unit: 1761

applicant would have no recourse at this time because the two year period for broadening patent claims has expired. Therefore, applicant is using the fortuitous and unrelated events which led to the first or parent reissue as granting applicant a right it would not have had if the fortuitous and unrelated events had not occurred. A reissued patent should not confer upon the patentee a procedural right that the patentee would not have had if the original patent had been kept.

According to applicant's way of thinking, if a patentee is lucky enough to have cause to file a broadening reissue within two years of the original patent, he is essentially given a free license to broaden the claims further and in entirely different or unrelated ways during the entire term of the patent as long as the patentee maintains a perpetual and continuing chain of reissue applications. This is contrary to the strong public policy intended to be enforced by the last paragraph of 35 USC § 251.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1761

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Corbin whose telephone number is (703) 308-3850. The examiner can normally be reached on Tuesday-Friday from 10 a.m. to 7:30 p.m. and on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3929. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A. Corbin/dh
May 17, 2002

ARTHUR L. CORBIN
PRIMARY EXAMINER

5/20/02